

REMARKS/ARGUMENTS

Reconsideration and withdrawal of all outstanding grounds of rejection is respectfully requested in light of the above amendments and the remarks that follow.

At the outset, applicant gratefully acknowledges the Examiner's indication that claims 5, 6, 10-13 and 18-28 contain allowable subject matter, subject to resolution of the obviousness-type double patenting rejections discussed below.

The Examiner has rejected claims 1, 5, 6, 8, 10 and 18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-26 of commonly owned U.S. Patent No. 6,644,247.

The Examiner has also rejected claims 1, 5, 6, 8 and 18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending application Serial No. 10/001,908 (now U.S. Patent No. 6,895,903).

The Examiner has also rejected claims 1, 5, 6, 14, 15, 16 and 18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of applicant's copending application serial no. 10/045,617 (now U.S. Patent No. 6,601,542).

In each of the above-identified grounds of rejection, the Examiner asserts that the claims are not patentably distinct from each other because both applications disclose a portable power module having a container, a gaseous fuel motor, an electrical generator, a radiator, an exhaust silencer, frequency switching and the same dimensions of the container.

The Examiner's analysis is faulty in that it considers the disclosure of the respective applications/patents rather than the claims of each. In this regard, see Section 804IIB1, wherein it is stated that "any obviousness-type double patenting rejection should make it clear: (A) The differences between the inventions defined by the conflicting claims-a claim in a patent

compared to a claim in the application; and (B) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claims in issue is an obvious variation of the invention defined in a claim in the patent.”

The essential question is whether the invention defined in a claim in this application is an obvious variation of the invention defined in a claim in the patent. In each of the rejections noted above, none of the claims of any of the patents relied upon by the Examiner include the requirement in independent claim 1 of this application calling for the gaseous fuel motor, generator, radiator and exhaust gas silencer being positioned inside the container when the portable power module is in the normal operating configuration, and there is no evidence of record justifying a conclusion that the claims is merely an obvious variation of the claims in the respective patents.

Accordingly, the obviousness-type double patenting rejections as applied to claims 1, 5, 6, 8, 10, 14, 15 and 16 are erroneous and should be withdrawn.

Independent claim 18 has been amended to incorporate the limitations of allowable dependent claim 19 thereby overcoming the obviousness-type double patenting rejection of that independent claim.

The Examiner has also rejected claims 1, 4, 7, 8, 14 and 15 under 35 U.S.C. § 103 as unpatentable over Bernard et al. (U.S. Patent No. 6,450,133) in view of Nettel (U.S. Patent No. 2,362,714), Staschik (U.S. Patent No. 6,393,775) and Uram (U.S. Patent No. 4,032,793). The rationale for this ground of rejection is set forth in detail on pages 4, 5 and 6 of the Official Action. Briefly, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to design a portable power module as disclosed by Bernard et al. including a fuel motor with a combustion chamber as disclosed by Nettel and a liquid coolant arrangement as disclosed

by Staschik and to further design the generator to produce more than one megawatt as disclosed by Uram.

With the prior art as cited and relied upon by the Examiner does not disclose, however, is the combination of a gaseous fuel motor, and electrical power generator, a radiator and an exhaust gas silencer all mounted and arranged within a container that is trailerable over public roads where the gaseous fuel motor, the generator, the radiator, and the exhaust gas silencer are positioned inside the container when the portable power module is in the normal operating configuration. In this regard, the motor 38 in Bernard is a liquid fuel diesel motor as clearly set forth in column 5 of the patent. The fact that Nettel discloses a combustion turbine 3 that receives fuel oil from a fuel tank 9 for combustion in the combustion chamber 8, adds nothing to the combination of references that would justify a conclusion of obviousness under 35 U.S.C. § 103.

As explained by applicant on pages 2 and 3 of the specification as filed, prior gaseous fuel systems that have been incorporated within a standard ISO shipping container were required, by reason of the size of the gaseous motor, to locate the exhaust gas silencer and motor coolant radiator on top of the container during normal operation. Furthermore, during movement between job sites, the exhaust gas silencer and radiator were required to be removed from the top of the container to facilitate separate transport over public roads. Moreover, applicant acknowledges on page 2 of the specification that mobile systems generating electrical power using liquid fuel motors capable of producing up to 2 megawatts of electrical power can be housed within a standard shipping container. This acknowledgment is indeed consistent with the disclosure in Bernard relating to liquid fuel motor systems.

In contrast, applicant has been able to arrange and to configure the gaseous fuel motor, electrical power generator, radiator and exhaust gas silencer, all within the confines of a standard container where all of those components remain positioned inside the container when the portable power module is in its normal operating configuration.

The prior art as cited and applied by the Examiner simply does not disclose or suggest such an arrangement and it is therefore respectfully submitted that the rejection is improper and should be withdrawn.

The Examiner has rejected claims 2 and 3 under 35 U.S.C. § 103 as unpatentable over the same combination of references and further in view of ordinary skill in the art. The Examiner contends that it would have been an obvious matter design choice to use a trailer as defined in claims 2 and 3.

This rejection necessarily falls for the same reasons presented hereinabove insofar as claims 2 and 3 dependent from claim 1 and no new prior art has been added to the rejection that would establish prima facie obviousness with respect to claims 1, 2 and 3.

The Examiner has also rejected claims 9, 16 and 17 under 35 U.S.C. § 103 as unpatentable over the prior art as applied to claim 1 and further in view of the ordinary skill in the art. Here, the Examiner contends that it would have been obvious to design the claimed power module to operate in accordance with the values disclosed in claims 9, 16 and 17. Here again, the rejection must fall in that claims 9, 16 and 17 all depend from independent claim 1 and no new facts have been produced that would establish prima facie obviousness with respect to the independent claim.

Nonelected claims 29-33 have been canceled, and it is, therefore, submitted that the application (including claims 1-18 and 20-28) is now in condition for immediate allowance. If

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there are any small matters that remain for a resolution, the Examiner is encourage to telephone the undersigned so that the prosecution of this application can be expeditiously concluded.

Respectfully submitted,

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